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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,686	10/24/2003	Tamotsu Yoshida	121036-0064	8677

35684 7590 08/25/2006

BUTZEL LONG
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ANN ARBOR, MI 48104

EXAMINER

POULOS, SANDRA K

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,686

Applicant(s)

YOSHIDA ET AL.

Examiner

Sandra K. Poulos

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 and 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections and objections except for those described below are overcome by applicant's amendment filed 6/19/06.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris (US 3,919,143) in view of Kobayashi et al (EP 811659) and Yagishita et al (US 4,931,509).

The rejection is adequately set forth in paragraph 6 of Office action mailed 12/22/05 and is incorporated herein by reference.

3. Claims 1-9 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris (US 3,919,143) in view of Yagishita et al (US 4,931,509) and Tomoshige et al (JP 07-278426).

The rejection is adequately set forth in paragraph 7 of Office action mailed 12/22/05 and is incorporated herein by reference.

Response to Arguments

Applicant's arguments filed 6/19/06 have been fully considered but they are not persuasive.

Applicant argues that Kobayashi uses the hydrotalcite to prevent metal corrosion while the current invention relies upon it to improve vulcanization rate; however, Kobayashi discloses that the hydrotalcite is used both for suppressing metal corrosion and improving the rate of crosslinking (pg 6, lines 36-40).

Applicant argues that the compression set characteristics would not have been obvious or present in the combination above, but has not given evidence to support for that position. Examiner maintains that since the composition contains the same components as claimed and is also vulcanized, it would have the same properties as those claimed.

Applicant argues that the polycarboxylic acids and hydrotalcites are used differently than in the current invention. This is argument moot since the current claims are drawn to a composition and those components in the composition are presented in the rejections set forth above.

In response to applicant's argument that Tomoshige is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Tomoshige and the current composition both contain halogen-containing acrylic elastomers, hydrotalcites, and onium salts. The presence of additional components such as epichlorhydrin rubber in Tomoshige's composition do not render it

Art Unit: 1714

nonanalogous art because other component substantially overlap those in the Morris composition and current invention.

Lastly, applicant argues that Tomoshige discloses a compression set at 125 degrees for 7 hours, not 150 degrees for 70 hours as claimed and Tomoshige does not teach or suggest the claimed values. This argument is moot because the rejection set forth by examiner in paragraph 7 of the previous Office action did not use the Tomoshige reference to teach in the compression set characteristics. Tomoshige would not necessarily meet the claimed properties because the reference alone did not contain all the limitations necessary, but rather, it was examiner's position that the *combination* of Morris in view of Yagishita and Tomoshige would result in the claimed composition and therefore would intrinsically meet those properties currently claimed.

Thus the rejections set forth above are maintained.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1714

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra K. Poulos whose telephone number is (571) 272-6428. The examiner can normally be reached on M-F 8:00-4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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